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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,713	09/04/2003	Angela McAree	22500-RA	7305

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EXAMINER

GONZALEZ, MADELINE

ART UNIT PAPER NUMBER

2859

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/654,713

Applicant(s)

MCAREE, ANGELA

Examiner

Madeline Gonzalez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133)..
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 14-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/5/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13, drawn to a device for measuring, classified in class 33, subclass 403.
 - II. Claims 14-20, drawn to a method for measuring windows, classified in class 33, subclass 194.
 - III. Claims 21-24, drawn to a method for making a template, classified in class 33, subclass 562.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II-III and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process, such as for measuring a distance between two points

3. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as for making a template, not necessarily for windows. See MPEP § 806.05(d).

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4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II and III, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. Williamson on February 17, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 5, 7-11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Trevino (U.S. 5,357,683).

Trevino discloses a tool, as shown in Fig. 1, having:

- at least one moveable arm 12;
- at least one base 16;

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- means 20 for attaching said at least one moveable arm 12 to said at least one base 16;
- at least one leg 14 attached to said at least one base 16;
- wherein said at least one leg 14 is extendible;
- mounting means 18 for removably affixing said tool proximate to an object to be measured;
- wherein said at least one base 16 has a generally disc-like shape comprised of semicircular top portion and semicircular bottom portion;
- a plurality of projections 22, as shown in Fig. 3, carried on a first surface of said semicircular top portion of said at least one base 16, proximate to the peripheral edge of said semicircular top portion;
- wherein said means for attaching comprises a pivot;
- wherein said moveable arm 12 carries gradations thereon, wherein the position of said gradations defines measurement units;
- wherein said at least one moveable arm 12 comprises a locking surface 24, wherein said locking surface is defined proximate to said first surface of said base 16, and wherein said locking surface 24 is dimensioned to receive and retain one of said plurality of projections 22; and
- wherein said at least one extendible leg 14 comprise two extendible legs 14b and 14c, wherein said two extendible legs 14b and 14c overlap one another when in closed position.

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8. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Valentine (U.S. 1,559,386).

Valentine discloses a tool, as shown in Fig. 1, having:

- at least one moveable arm composed by elements 18 and 19;
- at least one base 10;
- means for attaching said at least one moveable arm to said at least one base 10;
- at least one leg composed by elements 15 and 16 attached to said at least one base 10;
- and
- wherein said at least one leg comprises two opposingly-positioned, extendible legs (one leg composed by elements 15 and 16, and the other leg composed by elements 11 and 12).

9. Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Byrne (U.S. 550,904).

Byrne discloses a tool, as shown in Fig. 1, having:

- at least one moveable arm 9;
- at least one base 3;
- means 10 and 11 for attaching said at least one moveable arm 9 to said at least one base 3; and

- wherein said at least one base 3 has a generally disc-like shape comprised of semicircular top portion and semicircular bottom portion.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trevino (U.S. 5,357,683) in view of Acopulos (U.S. 5,713,135).

Trevino discloses all the subject matter claimed above in paragraph 7 with the exception of pins.

With respect to the pins: Acopulos discloses a tool, as shown in Fig. 8, having a pin 62, as shown in Fig. 6, as mounting means for removably affixing said tool to an object to be measured. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add pins as taught by Acopulos to the caps 18 disclosed by Trevino in order to securely mount the tool to the desired object.

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12. Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne (U.S. 550,904) in view of Novak (U.S. 845,009).

Byrne discloses all the subject matter claimed above in paragraph 9 with the exception of a plurality of projections and a plurality of receiving areas.

With respect to the plurality of projections and a plurality of receiving areas: Novak discloses a tool, as shown in Fig. 1, having a plurality of projections 1.1 carried on a surface, and a plurality of receiving areas defined between each pair of said projections, wherein each receiving area of said plurality of receiving areas is at least the width of an arm 12, whereby said arm 12 may be positioned between each said pair of projections. The purpose of the projections is for securing the arm at right angles and at 45 degrees angles. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add projections and receiving areas as taught by Novak to the tool disclosed by Byrne in order to easily position the arm 9 at 90 and 45 degrees angles.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Marsden, Ward, Hamalainen, Thorell and Hurt disclose related tool having projections.

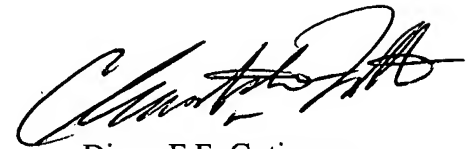
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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeline Gonzalez whose telephone number is (571) 272-2243. The examiner can normally be reached on Monday-Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MG



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